



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,189	12/10/1999	Tim Haynes	4173/2	9761

29858 7590 08/26/2003

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP  
900 THIRD AVENUE  
NEW YORK, NY 10022

EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 08/26/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/459,189

Applicant(s)

HAYNES ET AL.

Examiner

Milan S Kapadia

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### Notice to Applicant

1. This communication is in response to the application filed 10 December 1999. Claims 1-25 are pending.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 3, 4, 5, 6, 7, 8, 12, 14, 15, 16, 17, 18, 19, 20, 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danford-Klein et al. (6,041,318) in view of U-Haul's website ("www.U-Haul.com," January 25, 1998).

(A) As per claim 1, Danford-Klein discloses an object oriented rating system and method comprising :

a server which processes user inputs from a user's computer over a communications network and provides information responsive thereto to the user's computer over the communications network from which a service contract is generated and confirmed (Danford-Klein; fig. 1 and col. 4, lines 33-42), the server comprising:

a memory (Danford-Klein; col. 6, lines 3-4) in which is stored a plurality of data sets relating to (a) trucks which can be rented and associated rental prices for the trucks (Danford-Klein; Table 1(see col. 19, lines 20-25) and col. 14, lines 5-9) and (b) towing accessories and associated rental prices for the towing accessories (Danford-Klein; Table 1(see col. 19, lines 27-37) and col. 14, lines 5-9).

Danford-Klein fails to expressly disclose:

(b) towing accessories that can be rented and towed vehicles with which the towing accessories can be used,

(c) expertise-based guidance relating to trucks and towing accessories,  
and

programming for processing user inputs and data relating to the trucks and towing accessories to access the memory and provide expertise-based guidance to a user computer over the communications network

U-Haul discloses a website which teaches towing accessories that can be rented and towed vehicles with which towing accessories can be used (U-Haul; pages 7 and 8), expertise-based guidance relating to trucks and accessories (U-Haul; pages 7, 12, and 13), and programming for processing user inputs and data relating to the trucks and towing accessories to access the memory and provide expertise-based guidance to a user computer over the communications network (U-Haul; page 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Danford-Klein's system to include towed accessories that can be rented and towed vehicles with which towing accessories can be used, expertise-based guidance

Art Unit: 3626

relating to trucks and accessories and programming for processing user inputs and data relating to the trucks and towing accessories to access the memory and provide expertise-based guidance to a user computer over the communications network as disclosed by U-Haul with the motivation of helping customers plan their own do-it yourself move (U-Haul; page 18).

(B) Claim 2 differs from claim 1 by reciting the limitation "programming responsive to a user input identifying a vehicle to be towed which accesses the memory and provides to the user computer over the communications network data indicating availability or not of a towed accessory for the identified vehicle to be towed in accordance with the data set."

Danford-Klein fails to teach this limitation. However, Uhaul discloses a website which teaches programming responsive to a user input identifying a vehicle to be towed which accesses the memory and provides to the user computer over the communications network data indicating availability or not of a towed accessory for the identified vehicle to be towed in accordance with the data set (U-Haul; page 8; the Examiner interprets determining that the moving van is "not equipped to tow" as meeting this limitation). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Danford-Klein's system to respond to user input by identifying a vehicle to be towed which accesses the memory and provides to the user computer over the communications network data indicating availability or not of a towed accessory for the identified vehicle to be towed in

Art Unit: 3626

accordance with the data set as disclosed by U-Haul with the motivation of helping customers plan their own do-it yourself move (U-Haul; page 18).

(C) As per claim 3, Danford-Klein discloses memory in which is stored a data set relating to pick-up and drop-off locations for vehicles to be rented (Danford-Klein; col. 13, line 52-col. 14, line 4; The examiner interprets "origin/destination" as pick-up and drop-off locations.")

Danford-Klein fails to expressly disclose programming responsive to a user input identifying a geographical location in which the user desires to drop off a rented vehicle which accesses the memory and provides to the user computer over the communications network data indicating at least two locations closest to the geographic location input for pick-up and at least two locations nearest to the geographic location input for drop-off. U-Haul discloses a website which teaches a U-haul location finder that finds U-Haul locations closest to an address inputted by the user (U-Haul; page 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Danford-Klein's system to include a location finder as disclosed by U-Haul with the motivation of helping customers plan their own do-it yourself move (U-Haul; page 18).

(D) As per claim 4, Danford-Klein fails to expressly disclose the communications network as the Internet and the programming provides the data to the user computer in the context of one or more web pages. U-Haul discloses a website for truck renting to

Art Unit: 3626

be used over the Internet and providing data to user computer in the context of web pages (U-Haul; page 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Danford-Klein's system to include the use of the Internet and providing to customers the data in the context of web pages as disclosed by U-Haul with the motivation of helping customers plan their own do-it yourself move (U-Haul; page 18).

(E) As per claim 5, Danford-Klein discloses a payment-processing subsystem for establishing payment arrangements with the user in response to user inputs providing payment data communicated to the server over the communications network.

Danford-Klein; col. 4, lines 35-42; the examiner interprets "cause payment for such shipment" as a "payment-processing subsystem.")

(F) As per claim 6, Danford-Klein discloses the memory stores a data set relating to discounts available to qualified users, and wherein the server, responsive to user inputs providing data relating to discount eligibility, provides a quote for rental of a selected truck including a discount corresponding to the user inputted discount eligibility data (Danford-Klein; col. 14, lines 26-43).

(G) As per claim 7, Danford-Klein discloses the server, responsive to user inputs corresponding to truck selection (Danford-Klein; Table 1), pick-up and drop-off locations (Danford-Klein; col. 13, lines 52-54), and a pickup date (Danford-Klein; col. 15, lines 38-

Art Unit: 3626

43; The examiner interprets "shipping date" as "pick-up date"), generates a service contract data set, including a quote for the truck rental, associated with the user to be provided to the user's computer over the communications network(Danford-Klein; col. 4, lines 35-43; the examiner interprets "generate an order for such a shipment" as "generates a service contract" and interprets "generate a bill for such shipment" as "including a quote for truck rental.")

(H) As per claim 8, Danford-Klein discloses the user inputs include a selection of moving accessories; and wherein the server generates the service contract data set associated with the user and including the costs for the accessories in the quote for the truck rental. (Danford-Klein; Table 1 and col. 14, lines 5-9; Note output of rating server is returned as quote to client (Danford-Klein; col. 4, lines 35-43)).

(I) As per claim 12, Danford-Klein fails to expressly disclose a web page including data fields containing all information necessary for a service contract , the information either provided in response to user input data or data available from the system, in which all also data fields may be modified on the web page by the user without having to revert to another web page. U-Haul discloses a website with a rate request form where user can enter all data from one web page (U-Haul; pages 5-7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Danford-Klein's system to include the use a single web page for user input as



Art Unit: 3626

disclosed by U-Haul with the motivation of helping customers plan their own do-it yourself move (U-Haul; page 18).

(J) Claim 14 repeats features previously addressed in the rejections of claims 1 and 2 and are therefore rejected for the same reasons as claims 1 and 2, and incorporated herein.

(K) Claim 15 repeat features previously addressed in the rejection of claim 3 and is therefore rejected for the same reasons as claim 3, and incorporated herein.

(L) Claim 16 repeat features previously addressed in the rejection of claim 12 and is therefore rejected for the same reasons as claim 12, and incorporated herein.

(M) Claim 17 repeat features previously addressed in the rejections of claims 1-4 and 12 and is therefore rejected for the same reasons as claims 1-4 and 12, and incorporated herein.

(N) As per claim 18, Danford-Klein and U-Haul collectively teach wherein the expertise-based information includes a table of vehicle towing information (Danford-Klein; Table 1, col. 17-19) but collectively fail to expressly disclose:

receiving user-input selections of equipment including a selection of a truck for rental and a selection of a vehicle type for towing by the selected truck;

accessing the vehicle towing table to determine if the selected vehicle is capable of being towed by the selected truck; and

generating a towing advice indication for display to the user whether the selected truck is appropriate for towing the selected vehicle.

However, the combined system of Danford-Klein and Uhaul collectively teach displaying information on whether a selected truck can tow a selected vehicle (U-Haul; page 7). As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the collective system taught by Danford-Klein and U-Haul to access a vehicle towing table to determine if the selected vehicle is capable of being towed by the selected truck and generating a towing advice indication for display to the user whether the selected truck is appropriate for towing the selected vehicle, with the motivation of preventing the user from selecting a truck incapable of towing desired vehicle.

(O) Claim 19 differs from claim 3 by reciting the limitation "includes an affiliate table of truck-rental affiliates including geographic locations and a table storing travel directions to affiliates," in the preamble and the step of "accessing providing the travel directions for display to the user." Danford-Klein and U-Haul collectively fail to expressly disclose these limitations. However, since the combined system of Danford-Klein and U-Haul collectively teach determining the geographic locations of affiliates closest to a desired address and it is respectfully submitted, that storing and determining of travel directions between two locations are well known in the computer

Art Unit: 3626

arts. It is respectfully submitted, that it would have been obvious to one skilled in the art to modify the collective system Danford-Klein and U-Haul to include a table for storing truck-rental affiliates including geographic locations and travel directions to affiliates and accessing the tables and displaying the travel directions to the user, with the motivation of enabling the user to travel to the nearest affiliates.

(P) Claim 20 repeat features previously addressed in the rejection of claim 5 and is therefore rejected for the same reasons as claim 5, and incorporated herein.

(Q) Claim 22 repeat features previously addressed in the rejection of claim 6 and is therefore rejected for the same reasons as claim 6, and incorporated herein.

(R) Claim 23 repeat features previously addressed in the rejection of claim 7 and is therefore rejected for the same reasons as claim 7, and incorporated herein.

(S) Claim 24 repeat features previously addressed in the rejection of claim 8 and is therefore rejected for the same reasons as claim 8, and incorporated herein.

4. Claims 9, 10, 11, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danford-Klein (6,041,318) and U-Haul's website ("www.U-Haul.com," January 25, 1998) as applied to the claims 7, 20 and 22 above and further in view of Brandt et al. (6,125,384).

(A) As per claim 9, Danford-Klein and U-Haul collectively fail to expressly disclose the user inputs include a reservation confirmation command and wherein the server, responsive to the reservation confirmation command, generates a confirmation message to be provided to the user's computer through the communications interface. However, this feature is old and well known in the art, as evidenced by Brandt. Brandt discloses a car rental system over the Internet where the user submits a rental request (Brandt; col. 15, lines 42-44; the examiner interprets "submits" as a "reservation confirmation command") and the server sends a reservation confirmation to the client (Brandt; col. 19, lines 24-27). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the collective system taught by Danford-Klein and U-Haul with Brandt's teaching with regard confirmation requests and responses with the motivation of providing transaction support procedures for accessing software applications over the WWW (Brandt; col. 3, lines 17-24).

(B) Claim 10 differs from claims 1-9 by reciting the limitation "a web server for providing a plurality of web pages accessible through the Internet and for processing user inputs received through the Internet from a user's computer operating an Internet browser displaying the plurality of web pages, at least one web page having at least one input field for receiving the user inputs; and a backend server operatively connected to the web server and responsive to the user inputs."

Danford-Klein and U-Haul collectively fail to teach this limitation. However, Brandt discloses a car rental system where the client uses a web browser to make a reservation from a web server operatively connected to a backend server that sends a reservation confirmation to the web client (Brandt; fig. 1 and col. 19, lines 24-47). It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the collective system taught by Danford-Klein and U-Haul with Brandt's teaching with regarding an Internet based reservation system with the motivation of allowing a user of the web browser to more easily access software applications over the WWW (Brandt; col. 3, lines 25-26).

(C) As per claim 11, Danford-Klein, U-Haul, and Brandt collectively fail to expressly disclose the at least one program module, responsive to modifications of the user inputs prior to confirmation of the reservation, modifies the reservation information. However, since U-Haul teaches providing programming that enables a user to modify reservation information prior to confirmation of the reservation (U-Haul; pages 5-6), it is respectfully submitted, that it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the collective system taught by Danford-Klein, U-Haul, and Brandt to modify reservation information responsive to modifications by the user prior to confirmation of the reservation with the motivation of saving the users modifications.

(D) As per claim 21, Danford-Klein and U-Haul collectively fail to expressly disclose

Art Unit: 3626

the user inputs include credit card information. However, this feature is old and well known in the art, as evidenced by Brandt. Brandt discloses a car rental system over the Internet where the user can input credit card information (Brandt; col. 2, lines 16-33. It would have been obvious to one having ordinary skill in the art at the time the invention was made to expand the collective system taught by Danford-Klein and U-Haul with Brandt's teaching with regard to user inputting credit card information with the motivation of providing transaction support procedures for accessing software applications over the WWW (Brandt; col. 3, lines 17-24).

(E) Claim 25 repeat features previously addressed in the rejection of claim 9 and is therefore rejected for the same reasons as claim 9, and incorporated herein.

### **Response to Arguments**

5. Applicant's arguments with respect to claims 2, 3, and 14 have been considered but are moot in view of the new ground(s) of rejection.

(A) At pages 10-12 of the 7/29/03 communication, Applicant argues each of the applied references individually. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 3626

In particular, the teachings that Applicant argues are missing from the Danford-Klein reference are clearly disclosed in the respective teachings of U-Haul, when considered collectively with that of Danford-Klein, as discussed in detail within a prior Office Action (paper number 15) and in the preceding rejections, and incorporated herein.

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

6. Applicant's arguments filed 7/29/03 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 7/29/03.

(A) At pages 9-10 of the 7/29/03 response, Applicant argues that "neither Danford-Klein nor U-Haul disclose or suggest any systems for using user input and stored data to provide expertise-based guidance to a user computer" in reference to claims 1, 4-9, and 17-25. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Art Unit: 3626

In particular, the teachings that Applicant argues are missing from the Danford-Klein reference are clearly disclosed in the respective teachings of Uhaul, when considered collectively with that of Danford-Klein, as discussed in detail within a prior Office Action (paper number 15) and in the preceding rejections, and incorporated herein.

In addition, on pages 6, 7, 12 and 13 of the Uhaul reference, Uhaul teaches providing expertise-based guidance based on user input and stored data. The Examiner interprets the "Equipment Planning recommendations" as forms of "expertise-based guidance." Therefore, it is respectfully submitted that Danford-Klein and Uhaul collectively do teach systems for using user input and stored data to provide expertise-based guidance to a user computer.

(B) At pages 10-11 of the 7/29/03 response, Applicant argues that "...Examiner has properly reconstructed the claimed invention using hindsight" in reference to claim 2. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*



Art Unit: 3626

*Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In addition, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s), which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the

Art Unit: 3626

artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would

suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA),

Art Unit: 3626

obviousness is not based on express suggestion, but what references taken collectively would suggest.

(C) At page 12 of the 7/29/03 response, Applicant argues that “the Examiner has again provided no basis for his assertion that provision of the lacking features would be obvious to one of ordinary skill in the art...” in reference to claims 10 and 11. In response, the Examiner respectfully notes that the cited reference was never applied as a reference under 35 U.S.C. 102 against claims 10 and 11. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features. Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and

Art Unit: 3626

(iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, in reference to claims 10 and 11, the Examiner is concerned that, aside from merely alleging that certain claimed features are not obvious from DanFord-Klein, U-Hauld, and Brandt essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably

Art Unit: 3626

distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977). The Examiner maintains that the argued features would have been obvious over the applied prior art to one of ordinary skill in the art.

(D) At pages 12 and 13 of the 7/29/03 response, Applicant argues that "...the Examiner has acknowledged that both Danford-Klein and U-Haul fail to disclose, either singly or in combination, a web page including data fields providing all information which the system provides to a user information necessary for a service contract in response either to user input or data available from the system in which all data fields may be on the web page by the user without having to revert to another web page" in reference to claims 12 and 16. In response, the Examiner respectfully submits that the Examiner never acknowledged that the argued features were not taught by U-Haul. As shown above in the rejections of claims 12 and 16 and incorporated herein, the Examiner pointed to relevant sections of the U-Haul reference that taught the recited features. In particular, Uhaul's reservation request form is provided in response to user input. If a user decides obtain an online rate quote by selecting the link (i.e., provides input (see page 4 of the Uhaul reference) then the system does generate a web page in response to user input (Uhaul; pages 5-7). Moreover, the web pages provided are based on "data available to the system." For example, the pull-down menus provided

Art Unit: 3626

on page 6 of the Uhaul reference are definitely based on data of moving vans Uhaul provides, thus available to the system. In regards to arguments in reference to claim 16, similar reasoning applies and the preceding responses are incorporated herein (Also see MPEP § 608.01(m)).

Furthermore, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

### **Conclusion**

Art Unit: 3626

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

*mk*  
mk

August 19, 2003

*Alexander Calcinus*  
*Alexander Calcinus*  
PATENT EXAMINER  
Art 3626